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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 11/22/2011				
Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102			EXAMINER CHEEMA, UMAR	
			ART UNIT 2444	PAPER NUMBER
			MAIL DATE 11/22/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/765,043

Applicant(s)

MARUYAMA ET AL.

Examiner

UMAR CHEEMA

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-15 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-15 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/303)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Response to Amendment

1. This action is in response to the Request for Continued Examination (RCE) transmitted on 11/14/2011.
2. Claims 1-15 are pending with claims 1, 11 and 12 as being independent claims.
3. Claims 1, 11 and 12 have been further amended.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2011 has been entered.

Response to Arguments

5. Applicant's arguments and amendments filed on 14 November 2011 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by amending independent claims 1, 11 and 12 to add the new underlined limitations of* "a transmission control section for carrying out control for adding the sender e-mail address and the mail title set by the second setting section to an email for transmitting the image data, wherein the mail title is set as the title of the email, and

transmitting the email with the image data to the recipient address set by the first setting section", *has changes the scope of independent claims 1, 11, and 12, and will require further search and consideration*) to the claims which significantly affected the scope thereof.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda (US Pub. No. 2003/0128387) in view of Kagawa Tetsuya (hereinafter Kagawa) (JP Pub. No. 2002-135505) (Provided in IDS).
7. **As to claims 1, 11 and 12**, Noda discloses an image data transmitting method of a network scanner device (10) (Fig. 1) which attaches image data to electronic mail and transmits image data through a network (see at least abstract, ¶ (0007), communication device such as a network scanner and a network facsimile, for transmitting image data through e-mail) comprising steps of: a reading section for scanning a document to obtain image data (see at least ¶ (0041), Fig. 2, touch screen panel (20) to obtain data from the data memory (23)), a first setting section for setting up a recipient address to which the image data is to be transmitted (see at least abstract, ¶ (0013), Fig. 2, memory (23) stores the ID data of the addresses and addressors and a data selection control output from the memory data of addressees and

addressors as candidates of addressees when a user set a addressee to whom the image data is to be sent), a storage section in which sender e-mail addresses and mail titles are stored in association with each other, said sender e-mail addresses being distinct from a sending station address specifying the network scanner device (see at least ¶¶ (0005, 0006, 0013, 0047), storing **users register ID data which may be such as names, IP addresses, electronic mail address, and the like of addressees and addressors which are often used by the network users**), a second setting section for, when a sender e-mail address and mail title are selected from the sender e-mail addresses and mail titles stored in the storage section, setting up the selected sender e-mail address in place of the sending station address (see at least abstract, ¶¶ (0019, 0042-0048, Figures 3,4; selecting user from the list of users in touch screen panel (shown in Fig. 3, 001 user nameA etc.) and by selecting the selected user, inputting user's e-mail address, IP address (name to be registered), password and storage holder name and registering the user (Fig. 4))).

8. Although, Noda teaches the substantial features of applicant's claimed invention, Noda fails to expressly teach: a transmission control section for carrying out control for adding the sender e-mail address and the mail title set by the second setting section to an email for transmitting the image data, wherein the mail title is set as the title of the email, and transmitting the email with the image data to the recipient address set by the first setting section.

9. In analogous teaching, Kagawa exemplifies this wherein Kagawa teaches: a transmission control section for carrying out control for adding the sender e-mail address and the mail title set by the second setting section to an email for transmitting the image data, wherein the mail title is set as the title of the email, and transmitting the email with the image data to the recipient

address set by the first setting section (see **Kagawa: at least abstract, par. (0028-0030)**, wherein an Internet facsimile machine having a function of receiving email in compliance with the SMTP by using a communication control section 204 and a e-mail transmission and reception section 205 connect which is provided to register its own machine email address and domain name . . . and communication control may send and receive image data to the email indicates its own machine domain and corresponding to any of the mail addresses registered in advance in the address registration etc.).

10. Thus, given the teaching of Kagawa, it would have been obvious to one of the ordinary skill person in the art to combine the teaching of Kagawa into Noda for an email transmitting image data through a network. Motivation for doing so would have been facsimile machine provided with the function which sends and receives an E-mail via a local area network (LAN) or the Internet, and the function which sends and receives facsimile data in a facsimile transmission procedure via a public network (see **Kagawa: at least par. (0001)**).

6. **As to claim 2**, Noda discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section **(20)**(**Fig. 2**) for setting up the recipient address and the sender e-mail address simultaneously (**addressor registration control (21) and addressee registration control (22)**) (**Fig. 2**).

7. **As to claim 3**, Noda discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section carries out setting of the recipient address and the sender e-mail

address, in accordance with instructions by the sender (**see at least Fig. 2, addressor selection control and addressee selection control (24,25)**).

8. **As to claim 4**, Noda discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender e-mail address (**see at least Fig. 8 (Addressees List) and Fig. 10, list of Addressor user (100)**).

9. **As to claim 5**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender e-mail address are stored, wherein, on setting of the sender e-mail address, the recipient address is chosen from candidates of recipient addresses associated with the sender e-mail address (**see at least Fig. 6, e-mail transmission Address Book**).

10. **As to claim 6**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender e-mail addresses associated with IDs representing users are stored, wherein the sender e-mail address is automatically set up in accordance with an inputted ID (**see at least Fig. 13, selecting user of addressee automatically selects the e-mail address registered with the user**).

11. **As to claim 7**, Noda discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID

representing a user, as a condition for start of operations of the device (see at least ¶¶ (0046, 0047), Fig. 5).

12. **As to claim 8**, Noda discloses a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender e-mail address is inputted or chosen (see at least Fig. 12, input e-mail address of addressee/receiver and Fig. 13, select addressee from the list).

13. **As to claim 9**, Noda discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender e-mail address can be inputted through the network (see at least Figures 1,12).

14. **As to claim 10**, Noda discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see at least ¶¶ (0048, 0056)).

15. **As to claim 13**, Noda discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data, the step of setting the recipient address to which the image data is to be transmitted, and the step of setting the sender e-mail address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see at least ¶¶ (0047-0053), Figures 3, 4).

16. **As to claim 14**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by a user selection from addresses stored in the network scanner device in advance (**see at least Figures 3, 4**).

17. **As to claim 15**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by an input of the sender e-mail address by a user (**see at least ¶¶ (0047-0053)**).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./
Examiner, Art Unit 2444

/Djenane M Bayard/
Primary Examiner, Art Unit 2444